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Rejection of Claims 18, 20-37 and 60-65 Under 35 U.S.C. §112, First Paragraph

Claims 18, 20-37 and 60-65 stand rejected under 35 U.S.C. §112, first paragraph, on the grounds that these claims contain subject matter which is not described in the specification in such a way as to enable one skilled in the art to practice the invention. Applicants again respectfully traverse these rejections.

As in the previous Office Action and Applicants' previous Response, there are six general points at issue, and Applicants wish to respond point by point:

1. The Office Action objects that "the claims recite no 'specific' receptor to be inhibited, nor do they recite structurally defined components to practice the instant invention, in which each G-protein receptor dysfunction characterizes its own unique disease state . . . Therefore, the claims fail to specify how the skilled artisan knows when they have successfully practiced the instant invention, without requiring undue experimentation to discover how to make and use Applicants' invention."

First, Applicants note that claims 25-27 (D1 dopamine receptor), 30-31 (β 1-adrenergic receptor), and 33-34 (α 1A-adrenergic receptor), as well as the claims which are dependent on these claims, do in fact recite a "specific receptor" to be inhibited and do, in fact, recite "structurally defined components" in the form of amino acid sequences. Furthermore, claims 28, 32, and 35 further limit these claims by reciting the specific disorders which are treated. Applicants respectfully submit that it is well known in the art how to synthesize and administer specific polypeptides, as well as how to determine when these receptors are being inhibited, or these disorders are being beneficially treated. Therefore, Applicants respectfully submit that, at least with respect to these claims, ~~the subject matter is fully enabled and the rejection should be~~ withdrawn.

Moreover, as embodied in these claims, the specification discloses examples of methods relating to a multiplicity of different integral membrane proteins (e.g., G protein coupled receptors such as dopamine receptors, adrenergic receptors, etc.), and a multiplicity of different

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antagonist peptides (e.g., the peptides recited in claims 25-27, 30-31, and 33-34), which can be used to treat a multiplicity of different disorders for which administration of an antagonist is indicated (e.g., the disorders recited in claims 28, 32, and 35). Each of these examples, however, relates to more general methods which are enabled by the specification. Therefore, in light of the disclosure of these multiple examples or species, Applicants respectfully submit that the specification enables the broader claims, reciting for example the genus of integral membrane proteins (e.g., claim 18) or the genus of G-protein coupled receptors (e.g., claim 22), or reciting that the antagonist peptide consists essentially of at least four consecutive amino acid residues from at least one transmembrane domain of the integral membrane protein (or a conservative substitution variant thereof), or reciting generally that the disorder is one for which administration of an antagonist of the integral membrane protein is indicated. Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

2. The Office Action objects, with respect to claims 18, 21-23, 29-30, and 33, that the "specification is clearly deficient in providing sufficient guidance for knowing how to effect measurable phenotype as it relates to generic adrenergic receptors, as currently claimed, without requiring undue experimentation." Again, Applicants must respectfully disagree. The methods of the invention are to be used to treat disorders for which administration of an integral membrane protein is indicated. Such disorders are known in the art, and include those which are specifically disclosed in the specification. For each such disorder, the integral membrane protein must, by definition, be known in order for administration of an antagonist to be indicated. For each such integral membrane protein, the transmembrane domains will either be known, or may be easily determined without undue experimentation. For adrenergic receptors, there are methods, known in the art, for measuring inhibition of receptor activity (i.e., effecting measurable phenotype) either directly or indirectly. Thus, with respect to any given adrenergic receptor, and in light of the teachings of the specification, Applicants respectfully submit that one of ordinary skill in the art is enabled to choose an antagonist peptide consisting essentially of at

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least four consecutive amino acid residues from a transmembrane domain of that adrenergic receptor (or a conservative substitution variant thereof), and to administer that peptide to treat a disorder for which administration of an antagonist of that adrenergic receptor is indicated. Moreover, the specification provides several examples of the practice of such methods. Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

3. The Office Action objects that the claims do not "recite what structurally constitutes 'an antagonist...', nor what disorder or symptom is to be treated, each with their own unique etiology, nor when the skilled artisan knows when, where or what 'is indicated', because no such recitation is claimed so that the skilled artisan knows when they are in possession of the necessary components to practice the instant invention; thereby, requiring undue experimentation." Applicants are uncertain as to the meaning of this passage.

The term "antagonist" describes a molecule with a particular functional characteristic: It inhibits, opposes, or impedes the activity or functioning of some reference molecule. Thus, for example, an adrenergic receptor antagonist inhibits the activity of an adrenergic receptor. The structure of antagonists undoubtedly determines their ability to function as antagonists, but the term "antagonist" is to be understood functionally. Therefore, it is not clear why the Office Action objects that the claims do not "recite structurally what constitutes 'an antagonist'." With respect to the practice of the methods of the invention, it may be practiced whenever administration of an antagonist, understood functionally, is indicated. With respect to the antagonist peptides of the invention, they are indeed defined structurally, as consisting essentially of at least four consecutive amino acid residues from a transmembrane domain of the relevant integral membrane protein (or a conservative substitution variant thereof).

With respect to what disorders or symptoms are to be treated, and what "is indicated", Applicants note that the term "indication," and the phrase "is indicated," have special meanings in the medical arts. For example, an "indication" is defined as the "basis for initiation of a treatment for a disease or of a diagnostic test [which] may be furnished by a knowledge of the

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cause ..., by the symptoms present ..., or by the nature of the disease ..." (*Stedman's Medical Dictionary*, 26th Edition, Williams Wilkins, Baltimore, MD, 1995). Thus, administration of an antagonist of an integral membrane protein *is indicated* whenever there is basis for initiating treatment with such an antagonist. Such indications are well known in the art. Merely as an example, the entry for the β -adrenergic blocking agent (i.e., antagonist) COREG® in the *Physician's Desk Reference*, 53rd Edition, Medical Economics Company, Inc., Montvale, NJ, 1999 (copy attached), states under the heading "INDICATIONS AND USAGE" and subheading "Hypertension" that "Coreg (carvediol) is also indicated for the management of essential hypertension." *The Physician's Desk Reference* and the medical literature are teeming with such examples.

Therefore, Applicants respectfully submit that one of ordinary skill in the art will clearly know when administration of an antagonist of any given integral membrane protein is indicated, and will, in light of Applicants disclosure, be enabled to administer an antagonist peptide consisting essentially of at least four consecutive amino acid residues from a transmembrane domain of that protein (or a conservative substitution variant thereof). Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

4. The Office Action objects that "nowhere in the claims is there any recitation to indicate when such administration [of an antagonist of an EGF receptor to treat a neoplastic growth] 'is not indicated'; thereby encompassing all neoplastic growths . . . [that] the claims do not recite using any specific peptide to specifically 'inhibit growth' of any tumor" and that undue experimentation would be required to practice the invention. As noted above, the medical literature is full of examples of indications for administering antagonists of various integral membrane proteins, including EGF receptors. With respect to reciting specific peptides, the claims recite that the peptide consists essentially of at least four consecutive amino acid residues from a transmembrane domain of the relevant integral membrane protein (or a conservative

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substitution variant thereof). With respect to the comments relating to neoplastic growths and the inhibition of tumor growth, Applicants note again that the methods may be practiced to treat neoplastic growths for which administration of an EGF receptor antagonist is indicated, and that one of ordinary skill in the art can identify such indications without undue experimentation. Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

5. The Office Action objects that "the specification still provides contradictory evidence [relating to GABA receptors] on how to determine how and when to successfully practice the invention, without requiring undue experimentation [and that] the claims do not recite using any specific peptide to specifically 'inhibit GABA receptors' that effects any measurable phenotype." Again, the claimed invention is to be practiced whenever administration of an integral membrane protein antagonist is indicated, and such indications, including indications for the administration of GABA receptor agonists, are known in the art. Further, as before, the specific antagonist peptides are those which consist essentially of at least four consecutive amino acid residues from a transmembrane domain of the relevant integral membrane protein (or a conservative substitution variant thereof). Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

6. The Office Action objects that claims "the claims still fail to recite using any specific peptide to specifically 'inhibit dopamine and/or monoamine transporters' that effect any measurable cell type, disease state, or measurable phenotype" and therefore are not enabled. Again, Applicants point out that the specific peptides to inhibit any such transporter consist ~~essentially of at least four consecutive amino acid residues from a transmembrane domain of the~~ relevant transporter (or a conservative substitution variant thereof), and that methods of measuring the inhibition of such transporters are well known in the art. Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, first paragraph, based on these considerations should be withdrawn.

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Rejection of Claims 18-20, 27, and 36 Under 35 U.S.C. §112, Second Paragraph

Claims 18, 20-37 and 60-65 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite for reciting the phrases "administration of an antagonist . . . is indicated" and "consisting essentially of at least four consecutive residues".

The meaning of the phrase "is indicated" has been discussed extensively above. Applicants respectfully submit that the phrase is not indefinite and that its wide usage in the medical literature is indicative of the fact that one of ordinary skill in the art would understand its meaning. Thus, Applicants respectfully submit that the rejections under 35 U.S.C. §112, second paragraph, based on these considerations should be withdrawn.

With respect to the phrase "consisting essentially of at least four consecutive amino acid residues," Applicants draw the Examiner's attention to, for example, U.S. Pat. No. 5,298,599 (claim 5), U.S. Pat. No. 5,229,491 (claim 1), U.S. Pat. No. 5,229,286 (claim 1), U.S. Pat. No. 5,319,071 (claim 2), and U.S. Pat. No. 5,494,672 (claim 1). Each of these patents has claims drawn to peptides "consisting essentially of" some reference amino acid sequence, and provides evidence that this term has acquired a definite meaning within U.S. patent practice as it relates to claims involving polypeptides. In the present case, the reference sequence is any sequence of at least four consecutive amino acids from a transmembrane domain of the relevant integral membrane protein (or a conservative substitution variant thereof). A peptide which consists of fewer than four amino acid residues could not meet this definition. However, a peptide which consists in essence of four consecutive residues from such a transmembrane domain, but which includes additional residues at the N- and/or C-terminus which do not alter the essential function of the peptide in the context of the invention, would fall within the scope of the definition. Thus, in light of the accepted use of such claim language, Applicants respectfully submit that the rejections under 35 U.S.C. §112, second paragraph, based on these considerations should be withdrawn.

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SUMMARY

Claims 18, 20-37 and 60-65 are pending in the application and remain under consideration. No amendments to the claims are made herein. A petition for a two-month extension of time for response, up to and including September 28, 1999, and an authorization to charge the necessary fee to Deposit Account No. 20-0531, are transmitted herewith. Applicants believe that no other fees are due at this time. In the event that additional fees are due, the Commissioner is hereby authorized to charge such fees to said account.

Applicants request that the Examiner reconsider the application in light of the foregoing remarks. If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

Date: September 28, 1999
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395MJT7434/2.A864024_1

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